

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : BICKERS et al.
Serial No. : 10/049,410
Filing Date : 7 February 2002
For : HERBICIDAL AGENTS CONTAINING POST-EMERGENCE
HERBICIDES FOR SOIL APPLICATION
Examiner : PRYOR, Alton Nathaniel
Art Unit : 1616

745 Fifth Avenue
New York, NY 10151

PETITION UNDER 37 C.F.R. § 1.181
(Prematureness of final rejection - MPEP § 706.07(c))

Mail Stop: **Petitions (Group Director 1610 – George Elliott)**
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Please accept this petition against the holding of finality of the Office Action dated 4 March 2009. The Commission is authorized to charge any fee occasioned by this paper, or credit any overpayment of such fees, to Deposit Account No. 50-0320.

ACTION REQUESTED

The applicants request withdrawal of the final rejection as new grounds of rejection were made by the Examiner which were not necessitated by the applicants' amendments.

STATEMENT OF FACTS

The applicants received a non-final Office Action dated **28 May 2008** which included obviousness rejections of claims 14, 15, 17-20, 22, 24, 27 and 29-32 over Naranayan (U.S. Patent 5,231,070) and claims 14, 15, 17, 19, 20, 22, 24, 27 and 29-32 over Sanders (U.S. Patent 5,635,447).

The applicants filed a response on **28 November 2008** which addressed the rejections made in the Office Action of 28 May 2008. The previous claims were cancelled and new claims 33-58 were added for examination. Claims 33 (method) and claim 48 (composition) represented the new independent claims of the invention and is compared below to the previous independent method (claim 14) and composition (claim 17) claim which were considered during the 28 May 2008 Office Action:

Claim 14 (independent method claim considered during 28 May 2008 Office Action)	Claim 33 (independent method claim considered during 4 March 2009 Final Rejection)
<p>14. A method for controlling the growth of undesirable harmful plants pre-emergently with a post-emergence herbicide selected from the group consisting of bilanafos, diquat, paraquat, glufosinate, glyphosate and salts thereof, said method comprises applying a herbicidal composition to an environment where said undesirable harmful plant will reside prior to the emergence of said harmful plants,</p> <p>wherein the herbicidal composition comprises an effective amount of one or more post-emergence herbicides and an amount of a carrier material selected from the group consisting of fuller's earth, aerogels, high-molecular-weight polyglycols and polymers based on acrylic acid, methacrylic acid and copolymers thereof.</p>	<p>33. (New) A method for controlling the growth of undesirable harmful plants, which comprises applying an effective amount of herbicidal composition by the pre-emergence method,</p> <p>wherein the herbicidal composition comprises an effective amount of one or more herbicidal active substances selected from the group consisting of glufosinate, paraquat and salts thereof and an amount of a carrier selected from the group consisting of fuller's earth, aerogels, high-molecular-weight polyglycols and polymers based on acrylic acid, methacrylic acid and copolymers thereof.</p>

Claim 17 (independent composition claim considered during 28 May 2008 Office Action)	Claim 48 (independent composition claim considered during 4 March 2009 Final Rejection)
<p>17. A pre-emergence herbicidal composition, which comprises an effective amount of one or more post-emergence herbicides selected from the group consisting of bilanafos, diquat, paraquat, glufosinate, glyphosate and salts thereof and an amount of a carrier material selected from the group consisting of fuller's earth, aerogels, high-molecular-weight polyglycols and polymers based on acrylic acid, methacrylic acid and copolymers thereof,</p> <p>with the proviso that herbicidal compositions comprising paraquat and fuller's earth shall be excluded.</p>	<p>48. (New) A herbicidal composition which comprises an effective amount of one or more herbicidal active substances selected from the group consisting of glufosinate, paraquat and salts thereof and an amount of a carrier selected from the group consisting of aerogels, high-molecular-weight polyglycols and polymers based on acrylic acid, methacrylic acid and copolymers thereof.</p>

The applicants then received a Final Rejection dated **4 March 2009** which withdrew the rejection based on Naranayan and Sanders in favor of new obviousness rejections based on (1) Levitt (U.S. Patent 4,371,391); (2) Bieringer (U.S. Patent 6,159,900); and an obviousness-type double patenting rejection over U.S. Patent 6,770,594.

REASONS THAT CURRENT REJECTION IS A NEW GROUND FOR REJECTION

The applicants' amendment did not necessitate the new grounds of rejection under 35 U.S.C. 103 because the result of the applicants' claim amendments served to narrow the scope of the claims under consideration and did not introduce new limitations which were not previously disclosed in the claims, i.e. the scope of the claims under examination were disclosed in the originally filed claims.

Moreover, the guidelines for conducting a search are recited in MPEP 904.03 which states in part:

“It is a prerequisite to a speedy and just determination of the issues involved in the examination of an application that a careful and comprehensive search, commensurate with the limitations appearing in the most detailed claims in the case, be made in preparing the first action on the merits so that the second action on the merits can be made final or the application allowed with no further searching other than to update the

original search. It is normally not enough that references be selected to meet only the terms of the claims alone, especially if only broad claims are presented; ***but the search should, insofar as possible, also cover all subject matter which the examiner reasonably anticipates might be incorporated into applicant's amendment.*** Applicants can facilitate a complete search by including, at the time of filing, claims varying from the broadest to which they believe they are entitled to the most detailed that they would be willing to accept.

In doing a complete search, the examiner should find and cite references that, while not needed for treating the claims, would be useful for forestalling the presentation of claims to other subject matter regarded by applicant as his or her invention, by showing that this other subject matter is old or obvious.” (emphasis added)

This application has been subject to numerous Office Actions and each of the references now cited were available as prior art since the first Office Action was sent in to the applicants on 22 May 2002 (the ‘594 patent was published on 16 May 2002). As such, there is no reason why the references (and rejections therefore) cited in the final rejection were not earlier presented, especially given the narrower scope of claims now pending and the fact that prior to the final rejection, the Examiner had submitted four (4) Form 892s.

For these reasons, the applicants respectfully request that the finality of the rejection be withdrawn.

CONCLUSION

In view of the remarks made above, it is believed that the finality of the rejection should be withdrawn. Favorable reconsideration is earnestly solicited. The undersigned looks forward to hearing favorably from the Examiner at an early date, and, the Examiner is invited to telephonically contact the undersigned to advance prosecution. The Commission is authorized to charge any fee occasioned by this paper, or credit any overpayment of such fees, to Deposit Account No. 50-0320.

Respectfully submitted,
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